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09/390,824	09/07/1999	HANNSJORG OBERMAIER	10981400-7	7605

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EXAMINER

FIGUEROA, FELIX O

ART UNIT PAPER NUMBER

2833

DATE MAILED: 02/12/2004

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 30

Application Number: 09/390,824
Filing Date: September 07, 1999
Appellant(s): OBERMAIER, HANNSJORG

MAILED

FEB 12 2004

GROUP 2800

John A. Griecci
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed Oct. 8, 2003.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is incorrect.

The amendment after final rejection filed on Oct. 8, 2003 has been entered.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

The appellant's statement of the grouping of the claims in the brief is acknowledged.

(8) Claims Appealed

A substantially correct copy of appealed claim 1 appears on page 1 of the Appendix to the appellant's brief (page 7 of brief). The minor errors are as follows: In claim 1 line 2, "blukhead" should be --bulkhead--.

(9) Prior Art of Record

US 6,185,093	Moss	02-2001
US 5,708,563	Cranston, III et al.	01-1998

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1, 3, 4, 6-9, 13, 14 and 17-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moss (US 6,185,093) in view of Cranston, III et al. (US 5,708,563).

Moss discloses a computer connection system comprising a carrier (100) for connecting a planar printed circuit board card (28a) to a chassis (26a), wherein the card has a lower edge including a card system connector (32a), wherein the chassis defines an opening (102) for receiving a card and wherein the chassis includes a chassis system connector (106) to be placed in communication with the card system connector of the received card, the chassis system connector and opening defining a carrier-insertion direction (see Fig.10), comprising: a planar body (46) having a front end and a rear end, a first system connector (50) carried on the body and configured to mate and communicate with the card system connector in a card-insertion direction (see Fig.7) such that the plane of the printed circuit board card is parallel to the plane of the

body, and a second system connector (54) carried on the body and configured to mate and communicate with the chassis system connector, wherein the second system connector is in communication with the first system connector, wherein the first and second system connectors are configured such that the card-insertion direction differs from the carrier-insertion direction; wherein the body and the first and second system connectors are configured such that, with the card system connector mated to the first system connector, the second system connector fits insertably through the opening in the, chassis-insertion direction to mate with the chassis system connector. Moss discloses substantially the claimed invention except for the bulkhead in the card.

Cranston teaches the use of a planar printed circuit board card (71) including a bulkhead (73), the card bulkhead being approximately coplanar with the chassis opening when the card system connector is mated with the first system connector and the second system connector is mated with the chassis system connector to provide an external connection to the card (col. 4, lines 58-62). Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to use a card including a bulkhead being approximately coplanar with the chassis opening, as taught by Cranston, to provide an external connection to the card.

Regarding claim 3, Moss discloses the body including integral wiring to put the second system connector in communication with the first system connector.

Regarding claim 4, Moss discloses substantially the claimed invention except for the guide in the front end of the body. Cranston teaches a guide at the front end of the body, the guide being configured to guide movements of the card in mating the card

system connector with the first system connector, and the guide being configured to support the card when the card system connector is mated with the first system connector. It would have been obvious to a person having ordinary skill in the art at the time the invention was made to form the body of Moss including a guide at the front end, as taught by Cranston, to guide insertion of the card.

Regarding claim 6, Moss, as modified by Cranston, discloses substantially the claimed invention except for the second guide being adjustable. It would have been obvious to one having ordinary skill in the art at the time the invention was made to make one or both of the guides adjustable, since it has been held that the provision of adjustability involves only routine skill in the art. *In re Stevens*, 101 USPQ 284 (CCPA 1954).

Regarding claim 9, Moss discloses the chassis comprising a guide (120) configured to guide the carrier through the chassis opening, and configured to guide the second system connector to mate with the chassis system connector.

Specifically in claim 17, Moss, as modified by Cranston, teaches the claimed method.

Claim 5 remains rejected under 35 U.S.C. 103(a) as being unpatentable over Moss and Cranston, III et al., and further in view of Welsh (US 4,935,847).

Moss, as modified by Cranston, discloses substantially the claimed invention (see discussion on claim 4) except for the handle. Welsh teaches a handle (30) on the front end of the carrier (12) to facilitate the insertion and extraction of the carrier into the chassis (14). It would have been obvious to a person having ordinary skill in the art at

the time the invention was made to use a handle on the front end of the carrier, as taught by Welsh, to facilitate the insertion and extraction of the carrier into the chassis.

Claims 10, 12, 15, 29 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moss and Cranston, III et al., and further in view of Clements (US 5,963,681).

Regarding claim 10, Moss, as modified by Cranston, discloses substantially the claimed invention except for the guide being configured as a track composed of a translucent material; and a light source at the guide end within the chassis, the light source being configured to illuminate the guide end at the chassis opening, and the light source being configured to provide information on the status of the card. Clements teaches a guide/track (10) of translucent material and a light source (20) to provide information of the system (see col. 4 lines 50-65). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to a guide/track of translucent material and a light source, as taught by Clements, to provide information of the system.

Claim 11 remains rejected under 35 U.S.C. 103(a) as being unpatentable over Moss and Cranston, III et al., and further in view of Beak (US 5,496,185).

Moss, as modified by Cranston, discloses substantially the claimed invention except for the compressive electrically conductive material. Beak teaches the use of a compressive electrically conductive material connecting a card (10) to a chassis (16) to provide ground connection between the card and the chassis. It would have been obvious to a person having ordinary skill in the art at the time the invention was made to

use a compressive electrically conductive material connecting a card to a chassis as taught by Beak to provide ground connection between the card and the chassis.

(11) Response to Argument

In response to appellant's argument (in the first paragraph of page 5) that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Cranston teaches the use of bulkhead for providing an external connection means to electrically connect the circuit board to an external component (col. 4, lines 58-62).

In response to appellant's arguments against the references individually (i.e. against Moss in the second paragraph of page 5), please note that one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Nonetheless, it is noted that the suggestion to combine the reference is taught by Cranston.

In response to appellant's argument (in the third paragraph of page 5) that Cranston "fails to provide any suggestion to combine the references", please note that

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Cranston teaches the use of bulkhead for providing an external connection means to electrically connect the circuit board to an external component (col. 4, lines 58-62).

Thus, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to use a card including a bulkhead in the device of Moss, as taught by Cranston, to provide an external connection to the card.

In response to appellant's arguments (in the first paragraph of page 6) that there is no suggestion to combine Cranston and Moss because Cranston needs to shut down the computer for removal of the device and Moss is designed to provide removal from a live computer, it is noted that whether the computer is "shut down" or "live" does not prevent the circuit from having or being provided with a bulkhead for external connection.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Felix O. Figueroa
January 20, 2004

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